UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/767,143	01/29/2004	Pascal Charroppin	Q106386	4295

23373 7590 06/08/2009

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER	
SALIARD, SHANNON S	

ART UNIT	PAPER NUMBER
3628	

MAIL DATE	DELIVERY MODE
06/08/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/767,143	CHARROPPIN, PASCAL	
	Examiner	Art Unit	
	SHANNON S. SALIARD	3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *06 February 2009*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-10* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Applicant has amended claims 1 and 5. Claims 11 and 12 have been cancelled. No claims have been newly added. Thus, claim 1-10 remain pending and are presented for examination.

Response to Arguments

2. Applicant's amendments filed 06 February 2009, with respect to the rejections of claims 1-4 under 35 U.S.C. 112, Second Paragraph, have been fully considered and are persuasive. Thus, the rejections of claims 1-4 under 35 U.S.C. 112, Second Paragraph has been withdrawn.

3. Applicant's amendments and arguments filed 06 February 2009, with respect to the rejections of claims 5-10 under 35 U.S.C. 101 have been fully considered but they are not persuasive. While claims 5-10 identify the apparatus as RAM and/or a display, nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Benson, 409 U.S. at 71-72.* As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. To permit such a practice would exalt form over substance

and permit claim drafters to file the sort of process claims not contemplated by the case law. Cf., Flook, 437 U.S. at 593 (rejecting the respondent's assumption that "if a process application implements a principle in some specific fashion, it automatically falls within the patentable subject matter of § 101," because allowing such a result "would make the determination of patentable subject matter depend simply on the draftsman's art and would ill serve the principles underlying the prohibition against patents for 'ideas' or phenomena of nature."). *see Ex parte Langemyr*. Since the use of RAM and/or a display is considered to be a nominal recitation of structure, and nominal recitations do not convert an otherwise non-statutory process into a process, claims 5-10 are directed to non-statutory subject matter. Accordingly, the rejection of claims 5-10 under 35 U.S.C. 101 is upheld.

4. Applicant's arguments filed 06 February 2009, with respect to the rejections of claims 1 and 5 under 35 U.S.C. 103 (a) have been fully considered but they are not persuasive.

5. Applicant argues (with respect to claims 1 and 5), "The prior art fails to teach or suggest the following limitations respectfully recited in independent claims 1 and 5:

> wherein said comparing means provides for a determination as to whether there is a change in postal tariffs being compared, and said device further comprises means for emitting the alert message to the operator upon a determination that there is a change in the postal tariffs, whereupon the operator decides whether to replace the postal tariffs of the first table with the postal tariffs of the second table. (Claim 1)
>
> when a date of application of new postal data previously loaded in the franking system is identical to or earlier than a franking date desired by an operator of the franking system,
> comparing these new postal data with current postal data present in the RAM to determine whether there is a change in postal data; displaying a

> message on the display of the franking system alerting the operator to the expiration of tariffs when it has been determined that the postal data has changed; and
>
> a decision by the operator whether to replace the current postal data with the new postal data. (Claim 5)"

However, the Examiner disagrees. Dlugos et al discloses, "The apparatus 10 of the present invention can permit the uploading of data or information from a central office over a telephone subscriber line, which is initiated by the central office, to the apparatus 10 to **cause a message to be displayed on its display device 26. For example, the central office may wish to communicate to a postal scale or meter user that the postal rates are changing and the postal scale or meter rate tables, held on a flash programmable read-only memory module such as 30, will require modification**... Once data communications have been established 106, the central office uploads 108 a future rate information message from the remote central office database 110 which **may include instructions to the scale user to remove the scale's flash programmable memory module 30 and insert it into the socket 28** and then initiate a call to the central office by pressing a call initiation switch 38 on the apparatus 10. The microprocessor 36 causes the message to be displayed 112 on the display device 26. Referring to FIG. 3, **a user of the scale, for example, following the instructions displayed 196 on display device 26, as described above, takes the programmable nonvolatile memory module 30 from the scale and inserts it into the socket 28 and activates the call initiation switch 38**...Once the apparatus 10 and the programmable memory module 30 have been identified to the central office, the central office downloads 206 new rate data from its database 207 in an appropriate

format for the device receiving the programmable memory module 30 to the apparatus 10 which is stored in the random access memory 34. If the download is determined 208 to be without error, then the new rate data, which may be stored in the random access memory 34, is transferred 212 to the programmable read-only memory module 30. The transfer is checked for errors 214. If errors are detected, any data stored on the memory module 30 is erased 216 and a transfer 212 is re-tried. This message could instruct the user to transfer the module 30 to a designated scale or postage meter, for example." [col 4, line 27- col 5, line 42]. Thus, Dlugos et al discloses displaying a message alerting the operator of the expiration of tariffs and a decision by the operator whether to replace he current postal data with new data as required in claims 1 and 5.

Claim Rejections - 35 USC § 101

6. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. **Claims 5-10** are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 5-10 are directed to a series of steps. In order for a series of steps to be considered a proper process under § 101, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S.

63, 70 (1972). Thus, to qualify as patent eligible, these processes must positively recite the other statutory class to which it is tied (e.g., by identifying the apparatus the accomplishes the method steps), or positively recite the subject matter that is being transformed (e.g., by identifying the product or material that is changed to a different state). While claims 5-10 identify the apparatus as RAM and/or a display, nominal recitations of structure in an otherwise ineligible method fail to make the method a statutory process. *See Benson, 409 U.S. at 71-72.* As Comiskey recognized, "the mere use of the machine to collect data necessary for application of the mental process may not make the claim patentable subject matter." Incidental physical limitations, such as data gathering, field of use limitations, and post-solution activity are not enough to convert an abstract idea into a statutory process. In other words, nominal or token recitations of structure in a method claim do not convert an otherwise ineligible claim into an eligible one. To permit such a practice would exalt form over substance and permit claim drafters to file the sort of process claims not contemplated by the case law. Cf., Flook, 437 U.S. at 593 (rejecting the respondent's assumption that "if a process application implements a principle in some specific fashion, it automatically falls within the patentable subject matter of § 101," because allowing such a result "would make the determination of patentable subject matter depend simply on the draftsman's art and would ill serve the principles underlying the prohibition against patents for 'ideas' or phenomena of nature."). *see Ex parte Langemyr.* Since the use of RAM and/or a display is considered to be a nominal recitation of structure, and nominal recitations do

not convert an otherwise non-statutory process into a process, claims 5-10 are directed to non-statutory subject matter.

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

9. **Claims 1-3, 6, 7, 9, and 10** are rejected under 35 U.S.C. 103(a) as being unpatentable over Baum et al [US Patent 7,103,583] in view of Dlugos et al [US 6,463,133].

As per **claims 1 and 5**, Baum et al discloses a device alerting to the expiration of tariffs for a franking system, comprising a random access memory (RAM) for recording postal data (col 4, line 63-col 5, line 10) including:

a first table of postal tariffs relative to postal products and services (col 6, lines 34-38) and a processing unit for updating these postal tariffs (col 8, lines 53-55),

wherein said RAM further comprises a second table of postal tariffs (col 7, lines 59-62; Fig. 1); and

and said processing unit comprises means for emitting to a franking system a message alerting to the expiration of tariffs when a date of application of said postal tariffs of said second table is identical to or earlier than a desired date of franking and when one of said compared postal tariffs has been changed (col 8, lines 53-62,

communicating an instruction to implement a conversion when the current date falls short of the conversion date).

Although Baum et al does not explicitly disclose said processing unit comprises means for comparing said postal tariffs of the first and second tables, wherein said comparing means provides for a determination as to whether there is a change in postal tariffs being compared; Baum et al does disclose the release order number of the previous postage fee schedule (first table) is compared to the version number of the postage fee schedule to be loaded in the future (second table) (col 7, lines 45-54). Furthermore, Baum et al further discloses that the release number is the combination of a version and revision number (col 10, lines 22-24, revision number indicates that there is a change in data). While in Baum et al the release numbers of the tables are compared instead of the postal tariffs of the tables, it would have been obvious to one of ordinary skill in the art at the time of the invention to compare the postal tariffs in the tables instead of the release date for the similar reason of indicating a change in postal tariffs and to yield the predicted outcome of ensuring that the postal tariffs being utilized in the franking machine are valid and updated, as suggested by Baum et al (col 7, lines 46-48).

While Baum et al discloses emitting to a franking system a message alerting to the expiration of tariffs when a date of application of said postal tariffs of said second table is identical to or earlier than a desired date of franking and when one of said compared postal tariffs has been changed (col 8, lines 53-63), Baum et al does not disclose emitting a message to the operator of the franking system; and said device

further comprises means for emitting the alert message to the operator upon a determination that there is a change in the postal tariffs, whereupon the operator decides whether to replace the postal tariffs of the first table with the postal tariffs of the second table.

However, Dlugos et al discloses emitting to the operator of the franking system a message alerting to the expiration of tariffs (col 4, lines 32-35); and said device further comprises means for emitting the alert message to the operator upon a determination that there is a change in the postal tariffs (col 4, lines 32-35), whereupon the operator decides whether to replace the postal tariffs of the first table with the postal tariffs of the second table (col 4, lines 31-35; col 4, line 55- col 5, line 15; module "30" contains postal rate tables, and user plugs in module "30" to download new rate data into module "30"). It would have been obvious to one of ordinary skill in the art to include in the postal system of Baum et al the ability to emit to an operator that postal tariffs are expiring, and allow the operator to replace the expired tables as taught by Dlugos et al since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

As per **claim 2**, Baum et al further discloses wherein said second table of postal tariffs is loaded in the franking system at a periodicity defined by the Postal Service (col 9, lines 22-25).

As per **claim 3**, Baum et al further discloses wherein said second table of postal tariffs is loaded in the franking system from a remote resetting centre (col 3, lines 6-7).

As per **claim 6**, Baum et al further discloses wherein the new postal data are stored at the location of the current postal data when the operator has accepted the updating of these postal data (col 4, lines 12-22).

As per **claim 7**, Baum et al further discloses wherein the current postal data are stored in a blank part of the RAM, to be kept for control purposes (col 6, lines 14-17; col 7,lines 58-61).

As per **claim 9**, Baum et al discloses wherein the postal data comprise postal tariffs (col 12, lines 52-54).

As per **claim 10**, Baum et al further discloses wherein the postal data comprise postal products and services (col 12, lines 52-54).

10. **Claim 4** is rejected under 35 U.S.C. 103(a) as being unpatentable over Baum et al [US Patent 7,103,583] in view of Dlugos et al [US 6,463,133] as applied to claim 1, and in further view of Thiel [US 6,321,214].

As per **claim 4**, While Baum et al and Dlugos et al disclose loading a second table of postal tariffs in the franking system (Baum et al: col 7, lines 45-54), Baum et al and Dlugos et al do not disclose wherein said second table of postal tariffs is loaded in the franking system whenever credit is reloaded. However, Thiel discloses wherein said second table of postal tariffs is loaded in the franking system whenever credit is reloaded (col 22, lines 18-25). Therefore it would have been obvious to one of ordinary

skill in the art at the time of applicant's invention to modify the modified Baum et al to include the method disclosed by Thiel for the advantage of convenience, efficiency, and in order to be sure the proper rates are always present on the customer system. Furthermore, it would have been obvious to one of ordinary skill in the art to include in the postage system of the modified Baum et al the ability to load a new tariff table when credit is reloaded as taught by Thiel since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

11. **Claim 8** is rejected under 35 U.S.C. 103(a) as being unpatentable over Baum et al [US Patent 7,103,583] in view of Dlugos et al [US 6,463,133] as applied to claim 5, and in further view of Eckert [US 4,516,014].

As per **claim 8**, While Baum et al and Dlugos et al disclose emission of a message alerting to the expiring of tariffs (Dlugos et al: col 4, lines 32-35), Baum et al and Dlugos et al do not disclose wherein the emission of the message alerting to the expiration of tariffs is inhibited by the operator except for the first such message after the franking system has been put into operation. However, Eckert discloses wherein emission of an alerting message is inhibited by an operator except for the first such message after the franking system has been put into operation (col 8, line 66-col 9, line 14, Examiner interprets a message to be the same as a warning light). It would have

been obvious to one of ordinary skill in the art to include in the postage system of the modified Baum et al the ability to inhibit an alerting message as taught by Eckert since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

Conclusion

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SHANNON S. SALIARD whose telephone number is (571)272-5587. The examiner can normally be reached on Monday - Friday, 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Hayes can be reached on 571-272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Please address mail to be delivered by the United States Postal Service (USPS) as follows:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

Or faxed to:

(571) 273-5587 [Informal/ Draft Communications, labeled "PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to the Customer Service Window, Randolph Building, 401 Dulany Street, Alexandria, VA 22314

Shannon S Saliard
Examiner
Art Unit 3628

/S. S. S./
Examiner, Art Unit 3628

/John W Hayes/
Supervisory Patent Examiner, Art Unit 3628